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EXAMINER

MACASIANO, MARILYN G

ART UNIT

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3688

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,237	Applicant(s) PANARA, TIZIANO	
	Examiner MARILYN MACASIANO	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,12-15 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12-15 and 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to the Amendment filed on November 14, 2008. The Amendment cancelled claims 7, 11, 16 and 17, amended claims 1-6, 8-10 and 12-15, and added new claims 18-26. Therefore, the currently pending claims considered are claims 1-6, 8-10, 12-15 and 18-26.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-10, 12-15 and 18-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Rakavy et al. (U.S. Patent No. 5,913,040).

With respect to claims 1, 4 and 8, Rakavy et al. discloses a computer-based method of delivering auxiliary content comprising the steps of:

receiving over a network a request from a client terminal for an item of the auxiliary content, each item of the auxiliary content having an associated broadcast space comprising a respective time slot (col. 3, lines 4-43 and col. 7- 8, lines 51-3, fig. 4; col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8, lines 51-3 and col.15, lines 28-42, fig. 10); and

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selecting one of the items in accordance with a correlation between the broadcast spaces, and a time instant of issuance of the request and a web site accessed by the client terminal (col. 2-3, lines 66-14, col. 3, lines 52-63, col. 7, lines 51-55, col. 9, lines 47-49 and col. 14-15, lines 60-27).

With respect to claims 2, 5 and 9, Rakavy et al. discloses the method according to claim 4, wherein the broadcast space is segregated into network addresses, the request for auxiliary content includes a reference to the accessed web site, and the content selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space, and a network address of the accessed web site (col. 3, lines 8-43 and col. 5, lines 54-65, fig. 2).

With respect to claims 3, 6 and 10, Rakavy et al. discloses the method according to claim 19, wherein the client terminal has a configuration including at least one of a preferred language and a client jurisdiction, the broadcast space is further segregated into advertisement language and advertisement jurisdiction, and the selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space and the client configuration (col. 5 - 6, lines 66-3, fig. 2 and col. 7-8, lines 63-3).

With respect to claim 12, Rakavy et al. discloses an auxiliary content delivery server comprising:

a content database of records each defining an item of auxiliary content, and a broadcast space for delivery of the associated auxiliary content item, the broadcast space being segregated into time slots (col. 3, lines 4-43 and col. 7- 8, lines 51-3, fig. 4;

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col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8, lines 51-3 and col.15, lines 28-42, fig. 10);

content selection means in communication with the content database for selecting one of the items in accordance with a correlation between the broadcast spaces and a time instant of issuance of a request from a client terminal for the auxiliary content and a web site accessed by the client terminal (col. 2-3, lines 66-14, col. 3, lines 52-63, col. 7, lines 51-55, col. 9, lines 47-49 and col. 14-15, lines 60-27).

receiving means for receiving over a communications network the client terminal request for auxiliary content (col. 3, lines 4-26 and col. 9, lines 17-20); (col. 7, lines 45-61);

delivery means in communication with the content selection means for facilitating a download of the selected content to the client terminal over the network (col. 7, lines 45-61, fig. 4); and

response data processing means for processing response data received from the client terminal in response to the download auxiliary content (col. 5, lines 45-53, fig. 2, col. 7, lines 51-55, col. 9, lines 47-49 and col. 14-15, lines 60-27).

With respect to claim 13, Rakavy et al. discloses the auxiliary content delivery server according to claim 12, wherein the broadcast space is segregated into network addresses, the request for auxiliary content includes a reference to the accessed web site, and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space, and a network address of the accessed web site (col. 3, lines 8-43 and col. 5, lines 54-65, fig. 2).

With respect to claim 14, Rakavy et al. discloses the auxiliary content delivery server according to claim 21, wherein the client terminal has a configuration including at least one of a preferred language and a client jurisdiction, the broadcast space is further segregated into advertisement language and advertisement jurisdiction, and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space and the client configuration (col. 5 - 6, lines 66-3, fig. 2 and col. 7-8, lines 63-3).

With respect to claim 15, Rakavy et al. discloses the auxiliary content delivery server according to Claim 12, wherein the response data processing means is configured to maintain statistics associated with the effectiveness of the download auxiliary content based on the received response data (col. 5, lines 54-65, fig. 2).

With respect to claim 18, Rakavy further teaches wherein the request for auxiliary content includes an indication of the time instant of the issuance of the request from the client terminal, and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space, and the indication of the time instant of issuance of the request (col. 7, lines 51-55, col. 9, lines 47-49 and col. 14-15, lines 60-27).

With respect to claims 19-21, Rakavy further teaches wherein the request for auxiliary content includes an indication of the time instant of the issuance of the request from the client terminal, and the selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space, and the indication of the time instant of issuance of the

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request (col. 3, lines 4-43 and col. 7- 8,lines 51-3, fig. 4; col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8,lines 51-3 and col.15,lines 28-42, fig. 10).

With respect to claim 22, Rakavy further teaches wherein the response data comprises one of a number of times the downloaded auxiliary content was viewed, a duration the downloaded auxiliary content was viewed, a number of users who viewed the selected auxiliary content, and the time slots during which the selected auxiliary content was viewed.

With respect to claim 23, Rakavy et al. further teaches wherein the response data identifies the network address of the accessed web site (i.e. internet address are used for communicating on the network with which to communicate) (col. 3, lines 9-43, col. 5, lines 8-30; lines 54-65 and col.6, lines 9-20).

With respect to claim 24, Rakavy further teaches wherein the delivery means is configured to provide the client terminal with a network location of the selected one auxiliary content item (i.e. a third party may supply a location of a user or advertiser) (col. 9, lines 8-22).

With respect to claim 25, Rakavy et al. further teaches facilitating a download of the selected one auxiliary content item to the client terminal (i.e. downloading and presenting individual advertisements and other informational messages from a network to a local computer) (col. Lines 4-26, col. 5, lines 32-65); and

receiving from the client terminal response data in response to the downloaded auxiliary content (i.e. the system monitors the user's interaction with the

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advertisements and produces data on information gathered) (col. 3, lines 44-63, col. 14-15, lines 60-27).

With respect to claim 26, Rakavy further teaches further comprising generating a report based on the received response data (i.e. the system monitors the user's interaction with the advertisements and produces data on information gathered) (col. 3, lines 44-63, col. 14-15, lines 60-27).

Response to Arguments

4. Applicant's arguments filed 11/14/2008 have been fully considered but they are not persuasive.

5. The Applicant argues in reference to amended claims 1, 4, 8 and 12 that Rakavy et al. does not disclose the display of the advertisements based on the time instant of issuance of a request from the local computer for the auxiliary content, the local computer downloading the advertisement from the advertising system server based on any particular time information, but instead downloads the advertisement in the background, during periods of low network utilization. The Examiner notes that Rakavy et al. discloses a Polite Agent Technology currently used to download advertisement in the background during low line utilization can be **modified** to receive **current data**, such as news and stock quotes (col. 14-15, lines 60-27). Furthermore, an alternate embodiments and modification to the Polite Agent Technology, it is by basic algorithm,

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able to download and display advertisement at the instant the user requests the content.

The rejection of amended claims 1, 4, 8 and 12 under 102(b) is therefore maintained.

6. The Applicant argues that Rakavy et al. does not disclose selecting the auxiliary content based on a web site accessed by the client terminal. The Examiner notes that in several paragraphs, Rakavy et al. teaches a local computer initiating communication with a predetermined advertising system server, to include the World Wide Internet and commercial on-line services such as America Online, available from America Online In., CompuServe, available from H & R Block Inc., Prodigy, available from Prodigy Services, Microsoft Network, available from Microsoft Corp., as well as other services from a variety of companies such as AT&T Corporation and MCI Communications Corp. The predetermined advertising system server will select the next advertisement to be downloaded and transmit the network address of the advertising system server storing the advertisement. The local computer uses the transmitted network address to request the selected advertisement from the appropriate advertising system server (col. 4-5, lines 46-65). The rejection of amended claims 1, 4, 8 and 12 under 102(b) is therefore maintained.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Himmel et al. (U.S. Patent No. 6,275,854) Method and apparatus for detecting actual viewing of electronic advertising.

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b. Walker et al. (U.S. Pub. No. 2001/0018771) System and method for supplying supplemental information for video programs.

c. Katiyar et al. (U.S. Patent No. 7,366,682) System, method, and code for providing promotions in a network environment.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

POINT OF CONTACT

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARILYN MACASIANO whose telephone number is (571)270-5205. The examiner can normally be reached on 5/4/9 8:00-5:30 Mon.-Thur. 8:00-4:30 Fri..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Racquel Alvarez can be reached on (571)272-6715. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

M. M.
Examiner, Art Unit 3688
2/09/2009